

AMENDMENT
Serial No. 10/612,079
Docket No. ORW01-GN003

REMARKS

Introductory Comments

Claims 1-76 and 105 are pending in the present application. Claims 1, 2, 23-25, 41, 42, 63, 64, and 105 have been amended. Claims 77-104 have been cancelled. Reconsideration of the application is respectfully requested.

Examiner Interview

Applicant's representative wishes to thank Examiner Ramana for the courtesies extended during the telephone interview of February 22, 2007. The interview included a discussion regarding the prior art of record and the absence of any reference disclosing a biologically reabsorbable material as claimed. It was the Examiner's position that the prior art failed to disclose biologically reabsorbable materials having the capacity to degrade within, dissolve within, and/or be absorbed by the mammalian body in the context claimed. Applicant's representative proposed amending the claims to clarify that the structures and methods comprise biologically reabsorbable material(s). It was agreed, however, that this amendment would not exclude biologics that were biologically reabsorbable. It is respectfully submitted that the claims have been amended consistent with the proposed amendments discussed during the interview.

Instant Office Action – 35 U.S.C. § 112 Rejections

Claim 64 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as his invention. This ground of rejection is respectfully traversed.

Claim 64 includes the additional limitation of at least one fastener for mounting the lining to at least one of the stabilizing post of the tibial component and the inner surface of the femoral component at least partially defining the prosthetic intercondylar channel. The Office action alleges that this limitation "renders the claim vague and indefinite since it is unclear whether the fastener is for mounting to the intercondylar channel or just an inner surface of the femoral component." From this recitation, it

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would appear that some background may be in order to more fully understand Applicant's invention.

By way of background, and not of restriction, one of the purposes behind the lining in claim 64 is to decrease the play between the femoral component and the tibial component during movement of the joint. More generally, when a tibial component includes a stabilizing post, the post often contacts at least some of the interior surfaces of the femoral component that define the intercondylar channel when the joint is moved through its range of motion. The prior art, however, does not address the play between the prosthetic components at all, let alone by inserting a lining between the prosthetic components where they might otherwise contact one another approximate the intercondylar channel. Applicant's claimed lining is utilized to decrease the play between the tibial and femoral components after surgery and thereby provides increased stability to the joint. As time progresses after surgery, however, the play between tibial and femoral components gradually increases as the lining is eroded, while at the same time the native tissue surrounding the joint heals to compensate and maintain the stability of the joint with its increased play.

The Office action incorrectly alleges that this limitation ("at least one fastener for mounting the lining to at least one of the stabilizing post of the tibial component and the inner surface of the femoral component at least partially defining the prosthetic intercondylar channel") "renders the claim vague and indefinite since it is unclear whether the fastener is for mounting to the intercondylar channel or just an inner surface of the femoral component." The limitation at issue in claim 64 is improperly discussed in the Office action in the form of an "either or" limitation in that the limitation requires either: (1) mounting the lining to the intercondylar channel, or (2) mounting the lining to any inner surface of the femoral component. But this is not what claim 64 itself recites. Rather, claim 64 requires that if, and only if, the lining is mounted to the femoral component, the fastener is utilized to mount the lining to "the inner surface of the femoral component at least partially defining the prosthetic intercondylar channel". Only those surfaces of the femoral component that at least partially define the intercondylar channel would be encompassed by this limitation in claim 64. In other words, not every surface

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of the femoral component is one that at least partially defines the prosthetic intercondylar channel. The apparent indefiniteness perceived to be present and discussed in the Office action is illusory since claim 64 does not read on a lining mounted to any arbitrary femoral surface, but rather only reads on a lining mounted to a surface that at least partially defines the intercondylar channel. Because the claim limitation is specific to only those femoral surfaces that at least partially define the intercondylar channel, the claim limitation at issue is definite.

Reconsideration and withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of record for claim 64 are respectfully requested.

35 U.S.C. § 102 Rejections

Claims 1-14, 17, 20, 41-54, 57, and 60 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,592,622 to Ferguson ("Ferguson"). This ground of rejection has been fully overcome by the amendments to claims 1 and 41.

Claim 1 have been amended to recite, at least in part, a lining to be mounted to at least one of a tibial component of a knee replacement prosthesis and a femoral component of the knee replacement prosthesis so that the lining is between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periarticular stability between the tibial component and the femoral component, the lining comprising a biologically reabsorbable material.

Similarly, claim 41 has been amended to recite, at least in part, a lining to be mounted to at least one of the tibial component and the femoral component in the prosthetic knee joint so that the lining is between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periarticular stability between the tibial component and the femoral component, the lining comprising a biologically reabsorbable lining material.

It is respectfully submitted that Ferguson fails to disclose the foregoing limitations recited in claims 1 and 41. For this reason alone, claims 1 and 41 are in condition for allowance. Likewise, claims 2-14, 17, 20, 42-54, 57, and 60 that

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respectfully depend from either claim 1 or 41 are also in condition for allowance for at least the same reasons as for claims 1 and 41.

In light of the clear differences between the scope of Applicant's claims 1-14, 17, 20, 41-54, 57, and 60 and the disclosure of Ferguson, it can be clearly seen that Ferguson fails to disclose an embodiment reading on either claim 1 or claim 41, nor the claims depending therefrom. Reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejections of record over Ferguson for claims 1-14, 17, 20, 41-54, 57, and 60 are respectfully requested.

Claim 105 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,790,853 to Engelbrecht et al. ("Engelbrecht"). This ground of rejection has been fully overcome by the amendments to claim 105.

Claim 105 has been amended to recite, at least in part, a biologically reabsorbable lining being selectively attachable to at least one of the tibial component and the femoral component in the prosthetic knee joint so that the lining is mounted between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periarticular stability between the tibial component and the femoral component, whereby repositioning or degradation of the lining does not appreciably hinder the functionality of the femoral component and the tibial component.

It is respectfully submitted that Ferguson fails to disclose the foregoing limitation recited in claim 105. For this reason alone, claim 105 is in condition for allowance. Reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection of record over Engelbrecht for claim 105 are respectfully requested.

35 U.S.C. § 103 Rejections

Claims 23-25 and 27-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson"). This ground of rejection has been fully overcome by the amendments to claim 23.

Claim 23 has been amended to recite, at least in part, a first lining to be mounted to at least one of a tibial component and a femoral component so that the first lining is

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positioned between the tibial component and the femoral component approximate a prosthetic intercondylar channel to supplement periarticular stability between the tibial component and the femoral component, the first lining comprising a biologically reabsorbable material, and a second lining to be mounted to at least the other of the tibial component and the femoral component so that the second lining is positioned between the tibial component and the femoral component approximate the prosthetic intercondylar channel to supplement periarticular stability of the tibial component and the femoral component, the second lining comprising a biologically reabsorbable material.

It is respectfully submitted that Ferguson fails to disclose the foregoing limitation recited in claim 23. For this reason alone, claim 23 is in condition for allowance. Likewise, claims 24, 25 and 27-32 that depend from claim 23 are also in condition for allowance. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of record over Ferguson for claims 23-25 and 27-32 are respectfully requested.

Claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson") in view of U.S. Patent No. 6,616,698 to Scarborough ("Scarborough"). This ground of rejection has been fully overcome by the amendments to claims 1, 23, and 41.

As discussed previously, claims 1, 23, and 41 do not read on any disclosure of Ferguson. Likewise, Scarborough fails to disclose at least some of the same limitations that are not disclosed by Ferguson, particularly a lining comprising a biologically reabsorbable material as recited in the instant claims. For this reason alone, claims 1, 23, and 41 are in condition for allowance. Moreover, claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 that respectively depend from claims 1, 23, and 41, are also in condition for allowance for at least the same reasons as recited for claims 1, 23, and 31. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections of record over Ferguson in combination with Scarborough for claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 are respectfully requested.

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Claim 26 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson") in view of U.S. Patent No. 6,461,320 to Yencho et al ("Yencho"). This ground of rejection has been fully overcome by the amendments to claim 23.

As discussed previously, claim 23 does not read on any disclosure of Ferguson. Likewise, Yencho fails to disclose at least some of the same limitations that are not disclosed by Ferguson, particularly a lining comprising a biologically reabsorbable material as recited in the instant claims. For this reason alone, claim 23 is in condition for allowance. Moreover, claim 26 that depends from claim 23 is also in condition for allowance for at least the same reasons as recited for claim 23. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of record over Ferguson in combination with Yencho for claim 26 are respectfully requested.

Claims 63 and 65-76 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Reissue No. 29,757 to Helfet ("Helfet") in view of U.S. Patent No. 5,759,205 to Valentini ("Valentini"). This ground of rejection has been fully overcome by the amendments to claim 63.

Claim 63 has been amended to recite, at least in part, a lining mounted to at least one of the stabilizing post and an inner surface of the femoral component at least partially defining the prosthetic intercondylar channel to, at least temporarily, supplement periarticular stability between the stabilizing post and the prosthetic intercondylar channel, the lining comprising a biologically reabsorbable lining material. Neither Helfet, nor Valentini, disclose a biologically reabsorbable lining material mounted to at least one of the stabilizing post and an inner surface of the femoral component at least partially defining the prosthetic intercondylar channel. For this reason alone, claim 63 is in condition for allowance. Likewise claims 65-76 depending from claim 63 are also in condition for allowance, as Helfte and Valentini fail to disclose all of the claimed limitations of these claims.

Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of record for claims 63 and 65-76 are respectfully requested.

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Allowable Subject Matter

Applicant acknowledges the determination that claim 64 is allowable. In light of the grounds of rejection recited in the Office action and the due consideration the Examiner will give to Applicant's amendments, Applicant has refrained from prematurely rewriting this claim in independent form.

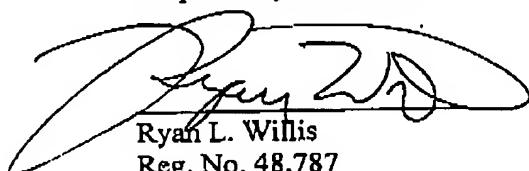
Conclusion

In light of the foregoing, it is respectfully submitted that claims 1-76 and 105, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record are respectfully requested.

The Commissioner for Patents is hereby authorized to charge any additional fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

In the event that the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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